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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,568	05/16/2001	Chul Hwa Paik	HAHA-0218	4095

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EXAMINER

REFAI, RAMSEY

ART UNIT PAPER NUMBER

2154

DATE MAILED: 09/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,568

Applicant(s)

PAIK ET AL.

Examiner

Ramsey M Refai

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☒ Claim(s) 6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 1-6 are presented for examination.

Specification

2. The disclosure is objected to because of the following informalities:
 - a. “the user and the host 10, 20” will be taken as “the user 10 and the host 20” throughout the application.Appropriate correction is required.

Claim Objections

3. Claim 6 is objected to because of the following informalities: “confirming the user whether he” in line 5 will be taken as “confirming whether the user” and “he is” in line 6 will be omitted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

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5. Claims 1 - 3, and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

b. Claim 1:

i. line 10: "identifying means"

c. Claim 2:

ii. lines 4-5 : "simultaneously post office protocol executing emailing"

iii. line 6: "endowing"

iv. line 23: "alarming the chat attempt"

d. Claim 3:

v. line 20: "the information drain"

e. Claim 6:

vi. line 9: "received the email"

vii. line 17: "alarming the chat attempt"

6. Claims 2 - 4 and 6 contain insufficient antecedent basis for the following limitations:

a. Claim 2:

i. line 11: "the email sender"

ii. line 27: "C.C. (carbon copy)"

b. Claim 3:

iii. line 4: "the user" and "the host"

iv. line 11: "the log-in ID"

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- v. line 20: "the information drain"
- vi. line 12: "the most recent IP"
- vii. line 13: "the port number"
- c. Claim 4:
 - viii. line 1: "Goods publicity system according to claim 1"
- d. Claim 6:
 - ix. line 2: "the internet"
 - x. line 4: "the user"
 - xi. line 5: "he"
 - xii. line 7: "the email" and "the host"

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 4 are rejected under 35 U.S.C. 103(a) as being anticipated by Bernstein et al (U.S. Patent Publication No. 2004/0128356) in view of Paarsmarkt et al (U.S. Patent No. 6,118,856).

4. As per claim 1, Bernstein et al show a system of simultaneously executing e-mailing and chatting, comprising:

a pair of web browsers of a sender and a receiver (paragraph [0013])

Internet contacting units for contacting to the web browsers (Claim 15, and paragraph [0053]) and;

an e-mail server for sending-receiving of e-mail between the sender and the receiver (paragraph [0021 and 0031]); and

CHmail(chatting-mailing) server (Figure 1, server 100) for simultaneously executing emailing and chatting between the sender and the receiver through identifying means for identifying a chatting attempter (paragraphs [0015 – 0016]) in a header of the e-mail (paragraph [0123]).

5. Bernstein et al fail to show the use of post office protocol emailing.

6. However, Paarsmarkt et al show a system using Post Office Protocol 3 (POP3) email format (column 4, lines 40-60). It would have been obvious to one of the ordinary skill in the art to combine the teachings of Bernstein et al and Paarsmarkt et al because Paarsmarkt et al's use of Post Office Protocol email formats would allow a user in Bernstein et al's system to view email anytime the user wants on a personal computer, even if the user is not connected to the Internet.

7. As per claim 4, Bernstein et al show a system wherein said Internet contacting units are selected from on-line means such as a modem, and a dedicated line, or wireless means such as a mobile telephone, a notebook computer, and a PDA (Claim 15, and paragraph [0053]).

8. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al (U.S. Patent Publication No. 2004/0128356) in view of Yamaguchi (U.S. Patent 6,499,055) and in further view of Apfel et al (U.S. Patent No. 6,405,225), yet in further view of Paarsmarkt et al (U.S. Patent No. 6,118,856).

9. As per claim 2, Bernstein et al show a method of simultaneously executing e-mailing and chatting, comprising the steps of:

framing an e-mail after turning on (inherent, a program needs to be turned on in order to function) a CHmail program simultaneously executing e-mailing and chatting (paragraph [0015 - 0016]);

attempting a chat with the e-mail sender by the e-mail receiver (paragraph [0015-0016]);

sending the e-mail to an e-mail receiver (paragraph [0015-0016])

confirming a response of the e-mail sender (paragraph [0016]; second user accepts invitation)

chatting between the e-mail sender and the e-mail receiver using a chat client programs (paragraph [0015-0016])

wherein, when there is no response of the e-mail sender for a chat attempt by the chat sender, the above method further comprises the steps of:

confirming on/off status of the computer of the e-mail sender(the chat receiver);

successively attempting chatting when the computer of the chat receiver is an "on status

automatically alarming the chat attempt to the chat receiver through the CHmail server when the computer of the chat receiver is an "off status" (paragraph [0017 - 0018]; presence detection),

10. Bernstein et al fail to show a method comprising endowing a port number by a server; inserting a log-in ID of the server, an IP address/host name, and a port number into the header of the e-mail; and wherein, if the e-mail sender sent the e-mail to a receiver of C.C. (carbon copy) as well as the e-mail receiver, it is possible that the communication between the e-mail sender and receiver is executed together with the receiver of C.C. at the same time or the use of post office protocol emailing.

11. Yamaguchi shows the use of port numbers, IP address, log-in ID of server in the header (column 3, lines 1 -67) but fails to show wherein, if the e-mail sender sent the e-mail to a receiver of C.C. (carbon copy) as well as the e-mail receiver, it is possible that the communication between the e-mail sender and receiver is executed together with the receiver of C.C. at the same time or the use of post office protocol emailing..

12. However, Apfel et al shows that the carbon copy (C.C.) data field is used for the purpose of transmitting the email message to other parties besides the addressee (column 11, line 63 - column 12, line 8) but fails the use of post office protocol emailing.

13. However, Paarsmarkt et al show a system that uses Post Office Protocol 3 (POP3) email format (column 4, lines 40-60).

14. It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Bernstein et al, Yamaguchi, Paarsmarkt et al, and Apfel et al because Yamaguchi's use of header information that contains IP address, port

number and log-in ID of server, Paarsmarkt et al use of post office protocol and Apfel et al use of carbon copy in Bernstein et al's system would allow a sender to send a chat request via email to multiple users.

15. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al (U.S. Patent Publication No. 2004/0128356) in view of Sanne (U.S. Patent 6,295,536) and in further view of Hoyle (U.S. Patent No. 6,771,290).

16. As per claim 3, Bernstein et al show a system using simultaneously executing post office protocol e-mailing and chatting at the same time between an user and a host on an Internet shopping mall, comprising:

a pair of web browsers of the user and the host (paragraph [0013]);

Internet contacting units for contacting the web browsers of the user and the host (Claim 15, and paragraph [0053]);

at least one web server connected to the web browsers of the user and the host for communicating between them (paragraph [0049 – 0053]);

a CHmail server for e-mailing and/or chatting between the user and the host (paragraph [0015 - 0016]);

network protective system preventing an inner system from an outer trouble and prevents the user information from the information drain (paragraph [0018 and 0024]).

17. Bernstein et al fail to show a first database including a table having the login ID and the most recent IP address/host name; a second database including a table having the port number,

the login ID of CHmail server; member database having an information of the user; and an advertisement database having a plurality of advertisement information.

18. However, Sanne shows the use of multiple database servers (Figure 1) that include user name, port number and IP addresses and member information (column 3, line 58 – column 4, lines 20) but fails to show the use of an advertisement database having a plurality of advertisement information.

19. Hoyle shows the use of an advertisement database having a plurality of advertising information (column 11, lines 42 – 64).

20. It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine the teachings of Bernstein et al, Sanne and Hoyle because Sanne's use of databases that contain IP address, port number and log-in ID of server and Hoyle's use of an advertisement database in Bernstein et al's system would have allowed a user to send an email to a receiver by obtaining the receiver info from the databases. The advertisement database would display advertisement banners to online shoppers on retail websites.

21. As per claim 5, Bernstein et al show a system wherein said Internet contacting units are selected from on-line means such as a modem, and a dedicated line, or wireless means such as a mobile telephone, a notebook computer, and a PDA (Claim 15, and paragraph [0053]).

22. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bernstein et al (U.S. Patent Publication No. 2004/0128356) in view of Cybul et al (U.S. Patent No. 6,246,997) in further view of Apfel et al (U.S. Patent No. 6,405,225).

23. As per claim 6, Bernstein et al shows a method using simultaneously executing e-mailing and chatting at the same time between an user and host on the Internet shopping mall, comprising the steps of:

 sending the e-mail to the host using a program simultaneously executing e-mailing and chatting at the same time after selecting goods (paragraph [0015-0016]);

 attempting chatting with the user by the host received the e-mail using the program; confirming a response of the user (paragraph [0015-0016]); and

 chatting between the user and the host using the chat client program in each computer of them (paragraph [0015-0016]);

 wherein, when there is no response of the user for a chat attempt by the host, the above-captioned method further comprises the steps of:

 confirming on/off status of the computer of the user; successively attempting chatting when the computer of the user is an "on status"; and automatically alarming the chat attempt to the user when the computer of the user is an "off status" and automatically alarming the chat attempt to the chat receiver through the CHmail server when the computer of the chat receiver is an "off status" (paragraph [0017 - 0018]; presence detection),

24. Bernstein et al fail to show a method comprising contacting to the Internet shopping mall by the user confirming the user whether he is shopping mall member or not; registering the user

as a member if he is not the member and wherein, if the user sent the e-mail to a receiver of C.C. as well as the host, it is possible that the communication between the user and host is executed together with the receiver of C.C. at the same time, and it is possible to change parts of the user and the host from each other, namely, chatting attempt may be executed by the user to get goods information.

25. However, Cybul et al shows contacting to the Internet shopping mall by the user (column 3, line 67 – column 4, line 15) confirming the user whether he is shopping mall member or not; registering the user as a member if he is not the member (column 2, lines 5 – 16) but fails to show wherein, if the user sent the e-mail to a receiver of C.C. as well as the host, it is possible that the communication between the user and host is executed together with the receiver of C.C. at the same time.

26. However, Apfel et al shows that the carbon copy (C.C.) data field is used for the purpose of transmitting the email message to other parties besides the addressee (column 11, line 63 – column 12, line 8).

27. It would have been obvious to one of the ordinary skill in the art at the time of the applicant's invention to combine Bernstein et al, Cybul et al, and Apfel et al because Cybul et al's use of verifying membership on an e-commerce site with Apfel et al's use of carbon copy to Bernstein et al's system would allow for members of an internet e-commerce business the ability to request to multiple online store managers to communicate in real-time regarding goods desired for purchase online.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ramsey M Refai whose telephone number is (703) 605-4361. The examiner can normally be reached on M-F 8:30 - 5:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ramsey M Refai
Examiner
Art Unit 2154

RMR
August 31, 2004



JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100